



UNITED STATES PATENT AND TRADEMARK OFFICE

CH
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,455	11/08/1999	CHRISTOPHER JAMES DANEK	435712000921	6666

25226 7590 03/03/2003
MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No. 09/436,455	Applicant(s) Denek
	Examiner <i>I. shay</i>	Group Art Unit 3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on November 21, 2002.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1-75, 77, + 79-82 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-75, 77, + 79-82 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

Art Unit: 3739

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 14-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not teach an expandable member and a plurality of legs.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 38, the term "adhesive means" indefinite, as there is no function positively associated with the means.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Revised section 102(e): For examining all Applications, whenever filed and for reexamining of all Patents, and for determining the prior art² dates of Patents and certain Application Publications:

A person shall be entitled to a patent unless- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the Invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in English language; or .

Pre-AIP section 374: For WIPO Publications of International Applications filed prior to November 29, 2000.

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.

Revised section 374: For WIPO Publication of International Applications filed on or after November 29, 2000.

The publication under the treaty defined in section 351 (a) of this title of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in section 102(e) and 154(d) of this title.

Effective Date Provision for the amendments to sections 102(e) and 374, as amended by H.R. 2215:

Except as otherwise provided in this section, section 4502 through 4504 and 4506 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by section 4504 shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director.

7. Claims 1-5, 18-30, 41, 45-47, 54, 57-59, 61-66, 70-71, and 74 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fleischman et al.

See e.g. figure 10, elements 32 and their content are considered the legs. See also column 7 line 15 – column 20, line 36.

8. Claims 1-19, 21-28, 30, 35, 38, 44, 45, 47, 55-65, 70, 71 and 74 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jackson et al.

See figures 4, 16A-D and 28-35 and column 5, line 5 to column 11, line 39; column 12 line 1 to column 33, line 26; and column 37 line 37 – column 38 line 4, wherein the conductors are considerd legs.

9. Claims 1,33, 34, 36-43, 67-70, 72-75, 77 and 79-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al. Jackson et al teach a device such as claimed except specifically calling for sterilization, the visuazation system; electrically conductive paint; locating the temperature detector between the leg and the resistively

heated element, forming the legs from a single sheet of stainless steel; and including an optical fiber and CCD. It would have been obvious to employ these measures, since they are notorious in the medical arts official notice which has already been taken; since they provide no expected result; and since they are not critical, and to employ a generator that would apply less power for shorter time, since Jackson et al give ~~not~~ minimum size for a desired lesion, thus producing a device such as claimed.

10. Claims 1-14, 18-30, 38, 41; and 44-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al in combination with Fleischman et al. Jackson et al teach a device such as claimed except the details of the handle and activator arrangement. Fleischman et al teach a device such as claimed except the balloon and the joining devices. It would have been obvious to the artisan of ordinary skill to employ the legs of Fleischman et al as the supports of Jackson et al, since Jackson et al gives no details of the supports and this would provide the electrodes, at the balloon surface and to employ the handle actuator and wire of Fleischman et al as the sheath control *since Jackson et al teach no particular activator structure*, for the embodiment of figure 5 of Jackson et al, thus producing a device such as claimed.

11. Claims 1 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischman et al in combination with Kordis et al ('870). Fleischman et al teach a device as claimed except the heat shrink fastener Kordis et al ('870) teach using a heat shrink fastener to secure the electrodes to the legs. It would have been obvious to the artisan of ordinary skill to employ a heat shrink fastener in the device of Fleischman et al, since this will maintain the electrodes in position, or to employ the temperature

sensors of Fleischman et al in the device of Kordis et al ('870), since this helps control the lesion as taught by Fleishman et al, thus producing a device such as claimed.

12. Applicant argues that Fleischman et al and Jackson et al no longer anticipate the claims. The examiner must respectfully disagree. There is no structure in the claims preventing the wires of Jackson et al or the element 32 and its contents ^{from being read on} ~~as~~ the legs recited therein.

13. Applicant's arguments with respect to claims 1-75, 77 and 79-82 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Shay whose telephone number is (703) 308-2215. The examiner can normally be reached on Tuesday-Friday.

If Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

David Shay:bhw
February 25, 2003



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330